REMARKS

Following entry of the present amendment, claims 1-17 remain pending in the application. Claim 18 has been cancelled. Only claims 1 and 10 are in independent form.

The specification stands objected to under 35 U.S.C. § 112, first paragraph, as allegedly failing to adequately teach how to make and/or use the invention, and thereby failing to provide an enabling disclosure.

Specifically, the Examiner has objected to "situations where "chronic pain" would "prevented"". Applicants have amended claim 1 to remove "prevention" from the claims thereby rendering moot the objection to the specification. Accordingly, Applicants respectfully submit that the objection to the specification set forth in the Office Action has been overcome and requests removal of this rejection.

Claims 1-9 stand rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth above in the objection to the specification. As stated above, Applicants have deleted "prevention" from the claims, thereby rendering moot the grounds for the present rejection. Accordingly, Applicants respectfully submit that the rejection of claims 1-9 under 35 U.S.C. § 112, first paragraph, have been overcome and requests that the Examiner remove his rejection on this ground.

Claims 1-9 also stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, as stated in the Office Action, claims 1-9 are rendered indefinite by the phrase "preventing...chronic pain" and thereby failing to clearly set forth the metes and bounds of the patent protection desired. As stated above Applicants have deleted "preventing" from the claims thereby rendering moot the objection to claims 1-9 under 35 U.S.C. § 112, second paragraph, as set forth above.

Both the specification and claims 1-9 and 18 stand objected to or rejected under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby allegedly failing to provide an enabling disclosure.

Applicants have cancelled claim 18 thereby rendering moot any objection thereto.

Specifically, the Examiner has objected to the phrases "NK_1 receptor antagonist" compounds or "GABA analog" compounds envisioned as useful for practicing the invention as claimed. The Examiner alleges that Applicants have failed to provide information allowing the skilled artisan to ascertain these compounds without undo experimentation.

Applicants respectfully submit that gabapentin is defined as a gamma-aminobutyric acid (GABA) structural analog in the Background of the Invention section of the present application. Applicants further submit that the skilled person would understand that other compounds with the same (anti-convulsive-analgesic etc.) properties as gabapentin (and pregabalin), which are also structural modifications of GABA, would be encompassed by the term "GABA analog". The Bryans et al., cited by the Examiner in the present Office Action, summarizes this definition in section 2, entitled, Rationale. The structures of gabapentin and GABA are given in Figure 1 of this reference. The term "GABA analog" is common general knowledge in the art. Therefore, one of ordinary skill, faced with determining whether a compound fell within the definition of GABA analog, would only need to carry out a few simple steps to reach a conclusion. Firstly, one of ordinary skilled could simply compare the structural formula of the compound to GABA and other compounds known in the art to be GABA analogs. If the structure is similar to that GABA, the skilled person could carry out a few binding and functional tests to determine whether the compound has similar properties to the best-known GABA analog, gabapentin. If it does, then the compound may be defined as a GABA analog.

Similarly, NK_1 receptor antagonists are defined in the Background of the Invention section of the present application. Further, in the present specification, on page 6, lines 6-26, numerous references to NK_1 receptor antagonist are provided. Thus, a person of ordinary skill has a wealth of documentation at his or her disposal to carry out tests to determine whether a compound is an NK_1 receptor antagonist. For example in the Horwell et al. patent cited by the Examiner, at columns 10-11, a number of references to experiments for identifying an NK_1 receptor antagonist are provided. Thus, on of ordinary skill, faced with determining whether a compound feel within the definition of an NK_1 receptor antagonist, could carry out a few simple steps to reach a conclusion.

Accordingly, it is respectfully submitted that there is no undo experimentation required on the part skilled person to identify whether a compound is a GABA analog or an NK_1 receptor antagonist. The experiments referred to above are standard pharmacological experiments requiring no undo skill on the part of the person carrying out said experiments.

Based on the above arguments and the cited references, Applicants respectfully submit that the Examiner has not made a *prima facie* case of non-enablement. Objectively, the specification teaches one skilled in the art how to make and use the invention. The Applicants have, therefore, complied with the statutory requirements of § 112. Accordingly, Applicants respectfully submit that the objection to the specification and the rejection of claims 1-9 and 18 under 35 U.S.C. § 112, first paragraph, have been overcome, and reconsideration and with removal of the rejection are respectfully requested.

Claims 1-6, 9-15, and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Specifically, claims 1-6, 9-15 and 18 stand rejected as the phrases "NK_1 receptor antagonist" and "GABA analog" allegedly render the claims indefinite. For the reason set forth immediately above for the rejection under 35 U.S.C. § 112, first paragraph, Applicant respectfully submits that the phrases "NK_1 receptor antagonist" and "GABA analog" are common terms which are well known to one of ordinary skill in the art and clearly define the subject matter which Applicants regard as the invention. Applicants have cancelled claim 18 thereby rendering moot any objection thereto.

Accordingly, for the above reasons, Applicants respectfully submit that claims 1-6 and 9-15 satisfies 35 U.S.C. § 112, second paragraph, and Applicants request that the Examiner remove his rejection on this ground.

Claims 1-18 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Horwell et al. and Bryans et al. Reconsideration of the rejection under 35 U.S.C. § 103 as unpatentable over Horwell et al. and Bryans et al. is respectfully requested.

In the Office Action, it is stated that Horwell et al. teach that NK_1 receptor antagonist compounds are useful for treating pain and Bryans et al. teach that GABA analog compounds are also useful for treating pain. However, Horwell et al. does not

teach nor suggest the combination of an NK_1 receptor antagonist with a GABA analog for the treatment of pain. Bryans et al. merely teaches that GABA analogs are useful in the treatment of pain but does not teach nor suggest the combination of a GABA analog with a NK_1 receptor antagonist for the treatment of pain. Since there is no teaching nor suggestion in either reference to combine the teachings therein with the other references, it is consequently respectfully submitted that the claims a clearly patentable over the combination, even if the combination were to be applied, in opposition to applicable law, reconsideration of the rejection is respectfully requested.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the reference (or combined references) or in the knowledge generally available to one of ordinary skill in the art to modify the reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference must teach or suggest all of the claimed limitations.

Horwell et al. disclosed NK_1 receptor antagonist compounds which maybe beneficial in treating pain. No mention is made in the Horwell et al. patent, however, for the combination of an NK_1 receptor antagonist with a GABA analog for the treatment of pain.

Bryans et al. disclosed GABA analogs useful for the treatment of pain. No mention is made in the Bryans et al. reference for the combination of a GABA analog with a NK_1 receptor antagonist for the treatment of pain.

The claims of the present application are directed to a method for treating chronic pain comprising administering to a patient in need of treatment an effective amount of a synergistic combination of a NK_1 receptor antagonist and a GABA analog.

Thus, there is no teaching or suggestion in the references to combine NK_1 receptor antagonist with a GABA analog in a synergistic combination to treat chronic pain. Second, one of ordinary skill in the art is faced with a large number of possible treatments for pain from many different classes of compounds. Thus, there is no incentive for one of ordinary skill in the art to choose a GABA analog and an NK_1 receptor antagonist in combination. Further, it is in no way obvious that the combination of the two components would result in a synergistic combination as required in claim 1. Accordingly, Applicants respectfully submit that the Examiner has not met his burden in

establishing a *prima facie* case obviousness. Accordingly, reconsideration of the rejection under 35 U.S.C. § 103 is respectfully requested.

Applicants further wish to point out that as demonstrated in the Examples, the combination of a GABA analog and an NK_1 receptor antagonist was found to be synergistic in the treatment of induced static allodynia (see pages 13-17 of the present application). Such a supra- additive effect is unexpected and surprising and indicates Applicants have provided an advance in potential pain therapies. Accordingly, Applicants respectfully submit that the data provided in the application demonstrates that the presently claimed invention is non-obvious in light of both Horwell et al. and Bryans et al. None of the references, either individually or in combination teach the claimed synergy. Reconsideration is respectfully requested.

In view of the present amendment and foregoing remarks, reconsideration of the rejection and advancement of the case to issue are respectfully requested.

The Commissioner is authorized to charge any fee or credit any overpayment in connection with the communication to our deposit account number 23-0455.

Respectfully submitted,

Dated: 11/05/04

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